



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,752	09/12/2002	Mohamed Khali	22171-321	2811
7590 06/13/2008			EXAMINER	
Bill R Naifch Haynes and Boone 901 Main Street Suite 3100 Dallas, TX 75202-9918			TRAN, ELLEN C	
			ART UNIT	PAPER NUMBER
			2134	
			MAIL DATE	DELIVERY MODE
			06/13/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/089,752

Applicant(s)

KHALIL ET AL.

Examiner

ELLEN TRAN

Art Unit

2134

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-30 and 70-75 is/are pending in the application.
- 4a) Of the above claim(s) 70-75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/089,752.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

1. This action is responsive to communication filed on: 10 March 2008 with recognition of an original application filed 12 September 2002, with acknowledgement of continuing data from a 317 of PCT/US00/27352 filed 4 October 2000, with a provisional application filed 5 October 1999.
2. Claims 16-30 and 70-75, are pending in this application. Claims 16-30 are elected. Claim 16 and is an independent claim. Claims 70-75 are withdrawn.

Response to Arguments

3. Applicant's arguments filed 10 March 2008 have been fully considered however they are not persuasive.
 - I) In response to applicant's arguments beginning on page 6, "*In KSR Int'l Co. v Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007), the Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does".

The Examiner disagrees with the argument. Both Inoue and RFC 1827 are directed to mobile communications. As stated by the KSR ruling it is reasonable to combine prior art in the same field of endeavor. In addition as indicated below Inoue teaches there is a need to guard against the leakage of secret information.

Art Unit: 2134

11) In response to applicant's argument beginning on page 7, *"However, Applicants respectfully submit that the Inoue, alone or in combination, does not teach the feature of "the home domain receiving and processing the registration request to generate a registration reply comprising one or more encryption keys for encrypting messages communicated between the mobile node, home domain, and the foreign domain." The Examiner indicated that such a feature is allegedly disclosed at Col. 19, lines 25-32 of Inoue. Applicants respectfully disagree.*

The Examiner disagrees with argument as indicated in the Inoue reference in response to a registration message keys are provided. The fact the reference indicates that a refusal message is first generated which prompts key exchange does not take away from the teaching of providing keys with the registration reply this is done in Inoue.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 16-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue U.S. Patent No. 6,167,513 (hereinafter '513) in further view of RFC 1827 IP Encapsulating Security Payload (ESP) (hereinafter RFC 1827).

s to independent claim 16, **"A method of providing secure communication between a mobile node and a home domain using a foreign domain, comprising:"** is taught in '513 col. 4, lines 50-67 "According to one aspect of the present invention there is provided a mobile

computer for carrying out communications while moving within a communication system in which a plurality of networks are inter-connected, said plurality of networks including one network at which a packet processing device is provided, said packet processing device having a function for applying an encryption and authentication processing to a packet transmitted by a computer inside said one network toward another computer outside said one network ... and a communication unit for carrying out a prescribed communication processing including an encryption and authentication processing of a packet to be transmitted from said mobile computer, according to recognition results obtained by the first recognition unit and the second recognition unit”, note encrypting communication between a mobile node through a plurality of networks is interpreted to be equivalent to secure communications between a mobile node, home domain, and a foreign domain;

“transmitting a registration request from the mobile node to the home domain” is shown in ‘513 col. 16, lines 24-35 “In the mobile IP scheme, when the mobile computer moves to a new visiting site, it is necessary for this mobile computer to send a registration message containing an information on a current location to the home agent which manages this mobile computer”;

“the home domain receiving and processing the registration request to generate a registration reply” is disclosed in ‘513 col. 18, lines 44-62 “As this point, the gateway 4b transfers this registration message as a packet in the encryption/link authentication format of FIG. 4D destined to the next hop gateway 4a. Then, this registration message arrives at the home agent 5a via the Internet 6 and the gateway 4a. Also, at the network 1b, for example, a setting is made in the management table of the gateway 4b so that a packet transferred from the

Art Unit: 2134

Internet 6 side which is destined to this mobile computer 2 will be transferred to the home agent 5a. By means of this setting, a packet destined to the mobile computer 2 that is transferred from the Internet 6 to the home network 1a of the mobile computer 2 will be given to the home agent 5a once, and further transferred to a visiting site of the mobile computer 2 from there.

At this point, the home agent 5a carries out the processing for encapsulating an IP packet destined to the original address (address in the home network 1a) of the mobile computer 2 within a packet in the mobile IP format destined to a current location address of the mobile computer 2, as described above”;

“comprising one or more encryption keys for encrypting messages communicated between and among the mobile node home, home domain, and foreign domain” is taught in ‘513 col. 19, lines 25-32 “When the above described registration processing is completed (that is, a case in which the permission response is received by the exchange of the key information”;

“and transmitting the registration reply from the home domain to the foreign domain and the mobile node” is shown in ‘513 col. 18, line 65 through col. 19, line 25 “Now, when the registration message is received, the home agent 5a transmits the registration response message in the IP format having the home agent 5a as a source and the mobile computer 2 as a destination, with respect to the mobile computer 2”;

the following is not explicitly taught in ‘513: **“the request comprising an identity of a user of the mobile node in encrypted form and network routing information in non-encrypted form”** however RFC 1827 teaches “ESP consists of an unencrypted header followed by

Art Unit: 2134

encrypted data. The encrypted data includes both the protected ESP header fields and the protected user data” in Section 3 on page 4, note encrypting user data is interpreted equivalent to user identity in encrypted form. In addition the unencrypted header is interpreted to be equivalent to the network routing information in non-encrypted form.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of ‘513 a mobile communication scheme using encryption and authentication to include a means that utilizes RFC 1825-1829 schemes to protect data exchanged. One in the art would have been motivated to perform such a modification because as indicated by ‘513 there is a need to guard against the leakage of secret information (see ‘513 col. 1, line 51 through col. 12) “For example, there is a problem as to how to prevent the leakage of the secret information of the organization to the external network, and there is also a problem as to how to protect resources and information connected to the domestic network. The Internet was developed originally for the academic purpose so that the primary concern was the free data and service exchanges by the network connections and the above described problem of security has not been accounted for. However, in recent years, many corporations and organizations are connecting to the Internet so that there is a need for a mechanism to guard the own network in view of the above described problem of security. To this end, there is a known scheme for use at a time of exchanging a data packet on the Internet, in which the content of the data packet is to be encrypted and an authentication code is to be attached before the transmission of the data packet to the external, and the authentication code is to be

verified and the data packet is to be decrypted at a received site. For example, the IETF (which is the standardizing organization for the Internet) specifies the encryption and authentication code attaching scheme for IP packets as the IP security standard (see, IETF RFC 1825-1829). According to this scheme, even when an outside user picks up the data packet on the external network, the leakage of data content can be prevented because the data content is encrypted, and therefore the secure communication can be realized”.

As to dependent claim 17, “wherein transmitting a registration request from the mobile node to the home domain comprises: transmitting the registration request from the mobile node to the foreign domain, and transmitting the registration request from the foreign domain to the home domain” is taught in ‘513 col. 18, lines 23-48.

As to dependent 18, “wherein transmitting the registration request from the foreign domain to the home domain comprises establishing a secure communications pathway between the foreign domain and the home domain” is shown in ‘513 col. 18, lines 25-48, note the encryption link authentication is interpreted to be equivalent to the secure communication pathway.

As to dependent 19, “wherein transmitting the registration request from the foreign domain to the home domain comprises establishing a secure communications pathway between the foreign domain and the mobile node” is disclosed in ‘513 col. 18, lines 44-62.

As to dependent 20, “wherein transmitting the registration request from the foreign domain to the home domain comprises establishing a secure communications pathway between the home domain and the mobile node” is taught in ‘513 col. 18, lines 44-62.

As to dependent 21, “wherein processing the registration request from the mobile node within the home domain comprises decrypting the encrypted form of the identity of the user” however RFC 1827 teaches that the sending userid and destination address are used to locate the correct Security Association for encryption on pages 6 and 7 in the ESP in Tunnel-mode and ESP in Transport mode, obviously the home domain performs decryption and determines the sending userid when the registration request message is decrypted.

As to dependent 22, “wherein generating a registration reply comprises encrypting at least one of the encryption keys” is taught in ‘513 col. 18, line 65 through col. 19, line 24 and ‘513 col. 12, lines 20-40, note the registration reply is sent in encryption/end-to-end authentication format and includes a key encrypted by a master key.

As to dependent 23, “wherein generating a registration reply comprises encrypting the encryption keys for encrypting messages to be communicated between the mobile node and me home domain, and between the mobile node and the foreign domain” is taught in ‘513 col. 18, line 65 through col. 19, line 24 and ‘513 col. 12, lines 20-40.

As to dependent 24, “ further comprising: decrypting one or more of the encrypted encryption keys” is taught in ‘513 col. 18, line 65 through col. 19, line 24 and ‘513 col. 12, lines 20-40.

As to dependent 25, “wherein generating the registration reply comprises: generating a first encryption key for encrypting messages to be communicated between the mobile node and the home domain, generating a second encryption key for encrypting messages to be communicated between the foreign domain and the home domain, and generating a third encryption key for encrypting messages to be communicated between

the foreign domain and the mobile node” is disclosed in ‘513 col. 18, line 65 through col. 19, line 24 and ‘513 col. 12, lines 20-40

As to dependent 26, “wherein generating the registration reply comprises encrypting at least one of the first and third encryption keys” is taught in ‘513 col. 12, lines 21-64 and col. 18, line 66 through col. 19, line 24, note the encryption/end-to-end authentication format is utilized in the registration reply, this format contains the encryption keys to be used between gateways.

As to dependent 27, “further comprising: decrypting at least one of the encrypted first and third encryption keys” is taught in ‘513 col. 12, lines 21-64 and col. 18, line 66 through col. 19, line 24, note the encryption/end-to-end authentication format is utilized in the registration reply, this format contains the encryption keys to be used between gateways.

As to dependent 28, “wherein the registration reply includes encryption keys that are encrypted and encryption keys that are not encrypted” is taught in ‘513 col. 12, lines 21-64 and col. 18, line 66 through col. 19, line 24, note the encryption/end-to-end authentication format is utilized in the registration reply, this format contains the encryption keys to be used between gateways.

As to dependent 29, “further including: extracting one or more of the encryption keys that are not encrypted from the registration reply” is taught in ‘513 col. 12, lines 21-64 and col. 18, line 66 through col. 19, line 24, note the encryption/end-to-end authentication format is utilized in the registration reply, this format contains the encryption keys to be used between gateways.

As to dependent 30, “further including: extracting and decrypting one or more of the encryption keys that are encrypted from the registration reply” is taught in ‘513 col. 12, lines 21-64 and col. 18, line 66 through col. 19, line 24, note the encryption/end-to-end authentication format is utilized in the registration reply, this format contains the encryption keys to be used between gateways.

Conclusion

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. It is noted, PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN “The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA

Art Unit: 2134

1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments (see MPEP 2123).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (571) 272-3842. The examiner can normally be reached from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/ELLEN TRAN/
Primary Examiner, Art Unit 2134
9 June 2008